REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 2, and 4-13, and 15-18 were previously presented. Claims 1, 5, 6, 12, 15, and 18 have been amended by the present amendment No new matter has been added

In the outstanding Office Action, claims 1-2, 5-7, 11, and 15-17 were objected to due to informalities; claims 1, 2, 4, 5, 8-10, and 15-17 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement; claims 6-13 and 15 and 18 were rejected under 35 USC 112, second paragraph, as being indefinite; claims 1, 6, 12, 15, and 18 were rejected under 35 USC 101 because "Apparatus" comprising: means or units does not include any functional structure; claim 18 was rejected under 35 USC 102(e) as being anticipated by Simonoff; claims 1, 4-6, 8-9, 12, and 15 were rejected under 35 USC 103(a) as being unpatentable over Simonoff in view of Morris et al.; claims 2, 7, 13, and 16 were rejected under 35 USC 103(a) as being unpatentable over Simonoff and Morris in view of Johnson; and claims 10, 11, and 17 were rejected under 35 USC 103(a) as being unpatentable over Simonoff and Morris in view of Erdelyi.

In response to section 3 of the Outstanding Office Action, Claims 1, 5, 6, and 15 have been amended exactly as suggested.

In response to section 4 of the Outstanding Office Action, Applicant respectfully traverses. Attention is respectfully invited to the following passage, which appears in the specification from line 16 of page 4 to line 3 of page 5:

> With the service providing apparatus, the information providing method and the program of the program storage medium, request information transmitted from any of the information processing apparatus is received, and data coordinated with the request information are acquired. Then, the acquired data are transmitted simultaneously to the plurality of information processing apparatus which belong to the same group. Consequently, data of a request from any of the

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> information processing apparatus of one group can be
> simultaneously shared by the plurality of information
> processing apparatus of the group. [Emphasis supplied.]

See also the passage in the specification running from lines 4-15 of page 21.

In response to section 6 of the Outstanding Office Action, Applicant respectfully

traverses. Webster's Dictionary defines the word "configure" as follows:

> Configure 1. to put together or arrange the parts of in a
> specific way or for a specific purpose; for into a configuration.
> 2. *Computers*. To put (a computer system) together by
> supplying a specific computer with appropriate peripheral
> devices, as a monitor and a disk drive, and connecting them.

As is apparent from the dictionary definition, the terminology "configured to" does not

merely "imply what the structure is capable of performing," which is the underpinning of the

outstanding rejection, but instead states that that the subject element is structured with

appropriate devices for the stated specific purpose. In that way, "configured to" terminology

clearly and positively states the metes and bounds of the claimed feature.

Of interest in the analysis of "configured to" language is its use in the case law. For

example, in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d

1596, 1599 (Fed. Cir., 1998), Judge Rich in interpreting the scope of "means plus function"

Claim 1 in issue identified the corresponding structure disclosed in the specification in issue

as follows:

> When independent claim 1 is properly construed in
> accordance with Section 112, Para. 6, it is directed to a
> machine, as demonstrated below, where representative claim 1
> is set forth, the subject matter in brackets stating the structure
> the written description discloses as corresponding to the
> respective "means" recited in the claims.

> 1. A data processing system for managing a financial
> services configuration of a portfolio established as a
> partnership, each partner being one of a plurality of funds,
> comprising:

> (a) computer processor means [a personal computer
> including a CPU] for processing data;

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(b) storage means [a data disk] for storing data on a storage medium;

(c) first means [an arithmetic logic circuit **configured to** prepare the data disk to magnetically store selected data] for initializing the storage medium;

(d) second means [an arithmetic logic circuit **configured to** retrieve information from a specific file, calculate incremental increases or decreases based on specific input, allocate the results on a percentage basis, and store the output in a separate file] for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds, [sic, funds'] assets and for allocating the percentage share that each fund holds in the portfolio;

(e) third means [an arithmetic logic circuit **configured to** retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund;

(f) fourth means [an arithmetic logic circuit **configured to** retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund; and

(g) fifth means [an arithmetic logic circuit **configured to** retrieve information from specific files, calculate that information on an aggregate basis and store the output in a separate file] for processing data regarding aggregate year-end income, expenses, and capital gain or loss for the portfolio and each of the funds. [Emphasis in bold added.]

Judge Rich's use of the "configured to" language to identify corresponding –structure—in the specification clearly underscores the "structural" connotation of the "configured to" terminology. Accordingly, in view of the dictionary definition, and the common use and understanding of the terminology, the objection to the "configured to" terminology is traversed.

In response to section 7 of the Outstanding Office Action, Applicant respectfully

traverses. According to paragraph 6 of 35 USC 112:

> An element in a claim for a combination [e.g.., for an apparatus comprising more than one element] may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material or acts described in the specification, and equivalents thereof.

That is all that Claims 1, 6, 12, 15, and 18 do. Accordingly, their format is expressly

authorized by the sixth paragraph of 35 USC 112.

It is believed that all of the prior art rejections can be efficiently dealt with together.

Specifically, it is Applicant's position that none of the cited references teaches or suggests the

simultaneous transmission feature which is recited in all of Applicant's independent claims

and which permits the real time interaction of all of the participants in a given chat room

while all of them are viewing and/or listening to the same content.

An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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